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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,903	12/30/2003	Myoung-Ho Jung	8836-221 (IE13077-US)	7410
22150	7590	12/12/2006	EXAMINER	
F. CHAU & ASSOCIATES, LLC 130 WOODBURY ROAD WOODBURY, NY 11797			WEBB, GREGORY E	
			ART UNIT	PAPER NUMBER

1751

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/748,903

Applicant(s)

JUNG ET AL.

Examiner

Gregory E. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

[Signature]
11/27/06

DETAILED ACTION

Claim Objections

1. Claims 7 remains objected to because of the following informalities:
2. The applicant uses the verb "phosphorate" to describe a chemical compound. As the term "phosphorate" is a verb it is indicating a process and not a chemical compound. Thus it remains unclear to the examiner what specific compound is created by the phosphorating process. Does the process create a phosphonate or a phosphate? What is the valence of the phosphorous group? It remains unclear. The applicant has failed in their response to address the examiner's interpretation of the claim. Is the examiner's interpretation correct? The applicant merely states that the term is known. The applicant does not addresses the issues raised by the examiner. Such a response does not further prosecution as the examiner has already provided a definition of the term.
3. The examiner maintains that a verb is inappropriately used to describe the compound as the phosphorating process could produce numerous different compounds including phosphates and phosphonates. Appropriate correction is required.

Response to Arguments

4. Applicant's arguments filed 9/12/06 have been fully considered but they are not persuasive.
5. The applicant's four pages of arguments can be summed up as follows: the prior art fails to teach the surfactant of formula 1.
6. The applicant does not state what if any differences exist. The applicant does not state what part of formula 1 is lacking in the prior art.

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7. In support of the examiner's argument one need only look to the applicant's own specification where formula 1 is defined. The formula is presented on page 6 of the instant specification. On page 9 of the specification the following exemplary embodiment of formula 1 is taught:

<Synthesis of a cleaning solution, according to an exemplary embodiment of the present invention>

1.0g of **ethoxylated 2,5,8,11-tetramethyl-6-dodecyne-5,8-diol**, represented by formula 2, as shown below, and 0.5g of ammonium perfluoroalkyl phosphorate were dissolved in 1000ml of deionized water. The solution was then filtered through a 0.021am filter to obtain a cleaning solution. Further, the ammonium perfluoroalkylethoxy phosphorate is an anionic surfactant containing fluorine that increases the solubility of the cleaning solution.

The examiner has cited this paragraph because it provides a concrete example of a compound which meets the limitations of formula 1 of claim 1. Such compounds are well-known in the detergent industry and are manufactured under various tradenames. For example the following terms are synonymous with 2,5,8,11-tetramethyl-6-dodecyne-5,8-diol: DYNOL.RTM. 604 and SURFYNOL 124.

Dynol 604 has been used industrially since at least 1996 (see for example US 5,786,127). A search for Dynol 604 yields 120 patent references. Of these references over 90 of them have a

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filing date prior to the applicant's claimed foreign priority date. Should the applicant get a patent on a compound known for over 7 years prior to the applicant foreign priority date?

Although the examiner has cited several references which specifically teach these well-known commercial surfactants, the applicant merely states that the references don't teach formula 1.

It is not the examiner burden to find a reference that teaches formula 1. The examiner burden is to find at least one compound that would meet the broad limitations of formula 1.

So we have several references teaching compounds meeting formula 1 and yet the applicant makes no arguments and provides no evidence how these well-known commercial surfactants fail to meet formula 1.

As such the previous rejections presented 6/19/2006 are maintained and made final.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period


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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory E. Webb whose telephone number is 571-272-1325. The examiner can normally be reached on 9:00-17:30 (m-f).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglass McGinty can be reached on (571)272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



11/27/06

Gregory E. Webb
Primary Examiner
Art Unit 1751

gew